REMARKS

Claims 8 and 10-17 have been cancelled and claims 1, 3-5 and 9 have been amended. Applicant reserves the right to pursue the original claims and other claims in this application and other applications. New claims 18 and 19 have been added. Claims 1-7, 9, 18 and 19 are pending in this application.

Claims 1-9 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 1 has been amended to clearly define that the claimed steps are being performed by technology. Applicants respectfully submit that all claims are in compliance with 35 U.S.C. §101.

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph. Claim 1 has been amended to address the Examiner's concerns. Applicants respectfully submit that all claims are in compliance with 35 U.S.C. §112.

Claims 1, 2, 5 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. (U.S. 5,982,994). Claims 3, 4, 6, 7 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mori et al. in view of Fabel (U.S. 6,209,779). Reconsideration is respectfully requested.

Claim 1 as amended is directed to a method for generating a mailing that comprises "storing at a data center a design for each of a plurality of mail pieces, each of said designs being in a format viewable from a remote computer via a network; receiving, at said data center, an order for a plurality of pieces of a first mail piece design from said remote computer via said network; combining, using a processor at said data center, said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run; arranging, using said processor, said single print run in a presort sequence based on recipient addressing information for said plurality of pieces of said first and second mail piece design; printing each of said plurality of pieces of said first mail piece design and said plurality of pieces of

said second mail piece design of said single print run in said arranged presort sequence on a corresponding print medium to produce a plurality of finished mail pieces in said presort sequence; and mailing said plurality of finished mail pieces."

Mori et al., in contrast, is directed to a high-speed network printer apparatus that can be used in common by LAN terminals (clients) having different communication protocols. As shown in Fig. 1, the network printer apparatus 20 includes a printing mechanism 23 composed of a recording system and paper feeding system, a mailbox 51 provided with bins for accommodating printed paper so as to store printed paper in a designated bin, a client 52 and a communication path 53. The printing information is supplied from the client 52 through a connector 26 and received by a LAN interface driver 21b, which identifies the communication protocol. The communication protocol controller 21-3, 21-4, 21-5 or 21-6 corresponding to the identified communication protocol controls communication in accordance with the predetermined protocol and receives printing data. The spooling controller 21-8 stores the printing information in the hard disk 24 and creates a queue for printing jobs. The printer controller 22 reads out of the hard disk 24 the printing information corresponding to the printing job of the highest priority which the printing mechanism 23 prints the image on paper. If the mailbox 51 is provided, the mailbox controller 20a obtains the number of the bin which is to store the printed paper directly or indirectly from the printing information and stores the printed paper in the bin. (Col. 6, line 30 to Col. 7, line 4).

Note first that Mori et al. is not directed to generating a mailing as is the present invention. Mori et al. is directed to a method and system in which multiple works stations (personal computers) that may use different communication protocols can be connected to a single high-speed printer for printing documents generated at the work stations. The system in Mori et al. is not related in any way to preparing a mailing.

There is no disclosure, teaching or suggestion in Mori et al. of storing at a data center a design for each of a plurality of mail pieces as is recited in claim 1. In Mori

et al., all of the printing information is supplied from the client, i.e., the workstation that generated the documents to be printed. There is, therefore, no storage of any types of designs for mail pieces in Mori et al.

There is also no disclosure, teaching or suggestion in Mori et al. of combining an order for a plurality of pieces of a first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run as is recited in claim 1. In Mori et al., each print job from a separate client is handled separately based on a priority designated by the queue. The Office Action contends that Col. 18, lines 54-55, which refers to the ability of the user to select single-side or both side printing for a print job, discloses this feature. This is clearly incorrect. The selection made by the user to print on only one side of a paper or both sides of a paper for the user's print job is in no way related to combining the user's print job with another print job from a different user. There is no disclosure, teaching or suggestion in Mori et al. of combining said order for said plurality of pieces of said first mail piece design with at least one other order for a plurality of pieces of a second mail piece design to produce a single print run as is recited in claim 1.

There is also no disclosure, teaching or suggestion in Mori et al. of arranging the single print run in a presort sequence based on recipient addressing information as is recited in claim 1. The Office Action contends that "Mori et al. obviously suggest about arranging a single print run in a presort sequence - Mori et al. teach in the abstract that printing jobs can be sorted out into the order of clients." (Office Action, page 7). The Office Action appears to be equating the mailbox 51 of Mori et al. with arranging the print run in a presort sequence of the present invention. This is simply not correct. In Mori et al. a mailbox 51 is provided with a plurality of bins for accommodating discharged paper as a post-processing mechanism of the network printer apparatus. When a user requests a print job, the user can designate the number of the bin in the mailbox in which the printed paper will be stored for later retrieval by the user. Alternatively, there is a correspondence between a user name or a group name and a bin registered in the mailbox information management

information in advance, so that designation of the bin in the mailbox for storing paper is not necessary at the time of requesting printing. (See Cols. 32-33). Thus, in Mori et al., each print job from a different user is kept separate from other user's print jobs by placing each different print job into a different bin. There is no combining of print jobs, nor is there any arranging of combined print jobs into a presort order based on recipient addressing information in Mori et al. This is in direct contrast with the present invention in which orders for a first and second mail piece design are combined into a single print run, arranged in a presort sequence based on addressing information for the mail pieces, and printed in the arranged presort sequence. There is simply no disclosure, teaching or suggestion of any of these features in Mori et al.

The reference to Fabel does not cure any of the above deficiencies, as it was relied upon for other features.

For at least the above reasons, Applicants respectfully submit that claim 1 is allowable over the prior art of record. Claims 2-7 and 9, dependent upon claim 1, are allowable along with claim 1 and on their own merits.

New claim 18 includes limitations substantially similar to those of claim 1. For the same reasons given above with respect to claim 1, Applicants respectfully submit that claim 18 is allowable over the prior art of record.

Claim 19, dependent upon claim 18, is allowable along with claim 18 and on its own merits.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims of this case are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,

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